

ESTTA Tracking number: **ESTTA673648**

Filing date: **05/21/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Kraft Foods Group Brands LLC
Granted to Date of previous extension	06/17/2015
Address	Three Lakes Drive Northfield, IL 60093 UNITED STATES
Attorney information	Susan H. Frohling Three Lakes Drive Northfield, IL 60093 UNITED STATES trademark@kraftfoods.com Phone:847-646-8657

### Applicant Information

Application No	86346128	Publication date	02/17/2015
Opposition Filing Date	05/21/2015	Opposition Period Ends	06/17/2015
Applicant	It's a 10, Inc. 153 Nurmi Drive Fort Lauderdale, FL 33301 UNITED STATES		

### Goods/Services Affected by Opposition

Class 003. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: A full line of hair care products, namely, shampoos, conditioners, hair rinses, hair cream, hair cream rinse, hair balms, hair styling balms and creams, hair gels, and hair sprays

### Grounds for Opposition

Dilution	Trademark Act section 43(c)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	308260	Application Date	08/01/1933
Registration Date	11/28/1933	Foreign Priority Date	NONE
Word Mark	MIRACLE WHIP		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 1933/01/24 First Use In Commerce: 1933/01/24 SALAD DRESSING AND SALAD SPREAD

U.S. Registration No.	2103423	Application Date	10/21/1996
Registration Date	10/07/1997	Foreign Priority Date	NONE
Word Mark	MIRACLE WHIP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1933/01/24 First Use In Commerce: 1933/01/24 salad dressing		

Attachments	71340290#TMSN.png( bytes ) Miracle Whipped Final.pdf(96764 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/shf/
Name	Susan H. Frohling
Date	05/21/2015

In the matter of the trademark application of It's a 10, Inc., for registration of the mark MIRACLE WHIPPED in Classes 3 for "A full line of hair care products, namely, shampoos, conditioners, hair rinses, hair cream, hair cream rinse, hair balms, hair styling balms and creams, hair gels, and hair sprays, Application No 86-346128, filed July 23, 2014, and published in the Official Gazette of February 17, 2015:

Opposer, Kraft Foods Group Brands LLC, a Delaware Limited Liability Company, believes it will be damaged by registration of the mark shown in the application and, therefore, opposes the registration of this trademark.

As grounds for this opposition, Opposer states as follows:

1. For many years prior to Applicant's filing date, Opposer has been engaged in the manufacture and sale of food products throughout the United States under the MIRACLE WHIP trademark. Opposer's date of first use of the MIRACLE WHIP mark extends back to 1933.
2. Opposer's MIRACLE WHIP branded products are available throughout the United States in thousands of stores: from mom-and-pop stores to grocery stores to convenience stores to club stores.
3. Opposer's yearly sales of products bearing or sold under the MIRACLE WHIP mark in the United States are approximately \$460MM. Products bearing the MIRACLE WHIP mark are of high quality and are identified and recognized as being exclusively from Opposer.
4. The MIRACLE WHIP mark appears on the packaging of Opposer's product as well as being featured prominently in print, TV and digital advertisements that are distributed nationally and are seen by hundreds of millions of people.
5. For many years, Opposer has maintained the website at *www.miraclewhip.com* that advertises and promotes MIRACLE WHIP branded products and is visited by consumers

nationwide. The MIRACLE WHIP brand is also on many social media platforms, including FACEBOOK, TWITTER, TUMBLR, and INSTAGRAM.

6. By virtue of the excellence of Opposer's products and long history of extensive promotional activities and sales thereof, the MIRACLE WHIP mark has gained a tremendous amount of goodwill such that the public has come to identify the business and products designated by the MIRACLE WHIP marks as those of Opposer. The MIRACLE WHIP mark acquired this goodwill long before any date on which Applicant may rely.

7. By virtue of Opposer's long use, extensive sales, advertising, and promotional efforts, Opposer's MIRACLE WHIP trademark is distinctive and famous. The MIRACLE WHIP trademark achieved that distinctiveness and fame prior to any date on which Applicant may rely.

8. Opposer owns all right, title and interest in and to the following registrations in the United States Patent and Trademark Office for the MIRACLE WHIP trademark, including:

<b>Mark</b>	<b>Reg. No.</b>	<b>Date of Registration</b>	<b>Goods/Services</b>
MIRACLE WHIP	2103423	10/07/1997	Salad Dressing
MIRACLE WHIP (Stylized)	308260	11/28/1933	Salad Dressing and Salad Spread

Said registrations in the name of Opposer are maintained on the Principal Register by the United States Patent and Trademark Office and are valid, in full force and effect, and constitute prima facie evidence of the validity of the mark shown and of Opposer's exclusive right to use it on the goods identified in the registrations, pursuant to §7(b) of the Lanham Act, 15 U.S.C. § 1057(b).

9. Opposer's Registration Nos. 308260 and 2103423 have become incontestable under 15 U.S.C. §1065 and the certificates of registration thereof constitute "conclusive evidence

of the validity of the registered marks[s] and of the registration of the marks[s], of the registrant's ownership of the mark[s], and of the registrant's exclusive right to use the registered mark[s] in commerce" pursuant to 15 U.S.C. §1065(b).

10. As a result of Opposer's over 80 years of use in commerce in the United States, the MIRACLE WHIP mark has acquired enormous value and has become famous and well-known to the consuming public and the trade as identifying and distinguishing goods exclusively from, or authorized by, Opposer.

11. Upon information and belief, It's a 10, Inc. is a Florida Corporation located at 153 Nurmi Drive, Fort Lauderdale, Florida 33301.

12. Applicant is not connected to Opposer in any way.

13. According to the records of the United States Patent and Trademark Office, on July 23, 2014, Applicant applied to register MIRACLE WHIPPED for "A full line of hair care products, namely, shampoos, conditioners, hair rinses, hair cream, hair cream rinse, hair balms, hair styling balms and creams, hair gels, and hair sprays" in Class 3.

14. Applicant's mark incorporates in its entirety Opposer's recognized MIRACLE WHIP trademark.

15. As a matter of law, Applicant was on constructive notice of Opposer's rights in the MIRACLE WHIP mark based on Opposer's registrations that were in existence prior to the application filing date, and Applicant had such constructive notice before adopting the mark and filing the application.

**CLAIM FOR RELIEF FOR DILUTION UNDER 15 U.S.C. §§ 1052(f), 1063**

16. Opposer repeats and realleges paragraphs 1 through 15 as if fully set forth herein.

17. Pursuant to 15 U.S.C. §§ 1052(f) and 1063, trademark applications may be opposed on grounds of dilution.

18. Opposer's MIRACLE WHIP mark is extraordinarily famous and well-known throughout the United States having been used, advertised and publicized extensively for over 80 years. The MIRACLE WHIP mark is inherently distinctive, has acquired secondary meaning such that it has become associated exclusively with Opposer by reason of Opposer's extensive advertising and use of the mark for decades, is the subject of incontestable federal trademark registrations, and is widely recognized by the general consuming public as a designation of source of Opposer's goods.

19. Applicant's filing date for MIRACLE WHIPPED in July 2014 is long after Opposer's MIRACLE WHIP trademark became famous.

20. Applicant's applied-for-mark MIRACLE WHIPPED incorporates "MIRACLE WHIP" which is identical to Opposer's famous, registered, and long-used MIRACLE WHIP mark and that calls to mind Opposer's famous MIRACLE WHIP mark. By virtue of the similarity between the mark shown in the application and the MIRACLE WHIP mark, the fame of the MIRACLE WHIP mark, and the exclusive association between the MIRACLE WHIP mark and Opposer, registration of the mark at issue would dilute or is likely to dilute Opposer's MIRACLE WHIP mark by impairing the distinctiveness of Opposer's MIRACLE WHIP mark to identify exclusively goods from Opposer in violation of Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

21. Registration of the mark shown in the application herein opposed would be inconsistent with Opposer's prior rights in the MIRACLE WHIP mark and with Opposer's

statutory grant of exclusive rights in the MIRACLE WHIP mark, and would destroy Opposer's investment and goodwill in its MIRACLE WHIP mark.

22. By reason of the foregoing, Opposer is likely to be harmed by registration of the mark shown in the application.

WHEREFORE, it is respectfully requested that Opposer's Opposition be sustained and that the mark sought to be registered by Applicant in Application Serial No. 86/346128 be denied.